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EXAMINER

AU, GARY

ART UNIT

PAPER NUMBER

2681

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/816,008	Applicant(s) JACKSON ET AL.	
	Examiner Gary Au	Art Unit 2681	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

the claimed invention is directed to non-statutory subject matter. Claims 17 and 22 are non-statutory subject matter in that they do not cite computer readable mediums but rather machine readable mediums, therefore, not directed to coursing a computer to perform some useful results.

The examiner suggests "a computer readable medium embodying thereon instructions, which when executed by a processor, causes the computer to perform a method comprising". See MPEP 2100 for a more accurate description of preambles for statutory computer related inventions.

Correction is required.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section

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351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 2, 10, 12, 13, 17, 18, 22-24 and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent No. 6,741,851 Lee et al. (Lee).

As to claims 1 and 17, Lee teaches a method and a machine readable medium having embodied thereon instructions, which when executed by a machine comprising: sending a message (PCI) on a wireless network to a mobile computer (lost portable telephone 110 – figure 1, col. 3 lines 36-50); and disabling the mobile computer upon receipt of the message (col. 4 lines 45-55).

As to claim 23, Lee teaches a system, comprising: a bus; a processor coupled to the bus; a network interface card coupled to the bus; and memory coupled to the processor (it is obvious that these are built in the system), the memory adapted for storing instructions, which upon execution by the processor sends a message on a wireless network to a mobile computer and disables the mobile computer upon receipt of the message (col. 8 lines 1-22).

As to claims 2, 18, and 24, Lee teaches a method and the machine readable medium of claims 1, 17, and 23, wherein sending a message (PCI) on a wireless network to a mobile computer (lost portable telephone 110 – figure 1, col. 3 lines 36-50) further comprises: pre-setting and storing a security code on the mobile computer (step 210 – figure 2, col. 4 lines 30-32); sending a security code message to the mobile computer using the wireless network (col. 3 line 66 – col. 4 line 6); and determining the

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authenticity of the sender of the message by comparing the sent security code message to the pre-set security code stored on the mobile computer (col. 4 lines 33-36).

As to claim 10, Lee teaches a method of claim 1, wherein disabling the mobile computer upon receipt of the wireless signal further comprises formatting a storage device on the mobile computer (col. 4 lines 45-55).

As to claims 12 and 22, Lee teaches a method of claims 1 and 17 further comprising sending a confirmation back to the message sender upon successfully disabling the wireless computer (col. 4 lines 64-67).

As to claims 13 and 28, Lee teaches a method of claim 2 wherein the security code comprises a Short message Service message (col. 3 lines 51-60).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3-6, 8, 9, 16, 19-21, and 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,741,851 Lee et al. (Lee) in view of US Patent

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No. 6,774,797 Freathy et al. (Freathy) and US Patent Application No. 2003/0199267

Iwasa et al. (Iwasa).

Considering claims 3, 19, and 25, Lee teaches the method, system and machine readable medium of claims 1, 17, and 23, but failed to teach initiating a system shutdown on the mobile computer once the message has been received; and requiring a BIOS password to be provided prior to booting the operating system for any system reboot subsequent to the receipt of the message.

In an analogous art, Freathy teaches initiating a system shutdown on the mobile computer once the message has been received (col. 4 lines 23-35). It is convenient to disable the unit to prevent the offender to take advantage of inactivity to commit an offense without detection (col. 4 lines 30-35).

In another analogous art, Iwasa teaches requiring a BIOS password to be provided prior to booting the operating system for any system reboot subsequent to the receipt of the message ([0040]). It is convenient to require a BIOS password so that only the owner can turn on the unit.

Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify Lee's system to include initiating a system shutdown on the mobile computer once the message has been received, as taught by Freathy, and requiring a BIOS password to be provided prior to booting the operating system for any system reboot subsequent to the receipt of the message, as taught by Iwasa, for the advantage of disable the unit to prevent the offender to take advantage of

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inactivity to commit an offense without detection and only the owner can turn the unit back on.

Considering claims 4, 20, and 26, Freathy further teaches queuing the message if the mobile computer is unable to immediately receive the message (col. 6 lines 45-53). It is convenient to wait and make sure that the mobile computer receives the message when it's available.

Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the combined system of Lee, Freathy, and Iwasa to include queuing the message if the mobile computer is unable to immediately receive the message, as taught by Freathy, for the advantage of ensuring that the mobile computer receives the message when it is available.

Considering claim 5, Freathy further teaches receiving the queued message upon power up if the mobile computer was powered down when the message was received (col. 4 lines 23-36). It is convenient to wait and make sure that the mobile computer receives the message when it's available.

Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the combined system of Lee, Freathy, and Iwasa to include receiving the queued message upon power up if the mobile computer was powered down when the message was received, as taught by Freathy, for the

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advantage of ensuring that the mobile computer receives the message when it is available.

Considering claim 6, Freathy further teaches receiving the queued message upon waking if the mobile computer was in a suspended state when the message was received (col. 6 lines 40-53). It is convenient to wait and make sure that the mobile computer receives the message when it's available.

Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the combined system of Lee, Freathy, and Iwasa to include receiving the queued message upon waking if the mobile computer was in a suspended state when the message was received, as taught by Freathy, for the advantage of ensuring that the mobile computer receives the message when it is available.

Considering claims 8, 21, and 27, Freathy further teaches ascertaining the current location of the mobile computer upon receipt of the message; and sending the location back to the originator of the message (col. 4 lines 1-11). It is convenient for the server to receive the location of the mobile computer and to retrieve the mobile computer.

Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the combined system of Lee, Freathy, and Iwasa to include ascertaining the current location of the mobile computer upon receipt of the

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message and sending the location back to the originator of the message, as taught by Freathy, for the advantage of receiving the location of the mobile computer and retrieving the mobile computer.

Considering claim 9, Freathy further teaches ascertaining the location of the mobile computer further comprises receiving GPS location information on the mobile computer (col. 6 lines 22-39). It is convenient for the server to receive the location of the mobile computer and to retrieve the mobile computer.

Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the combined system of Lee, Freathy, and Iwasa to include ascertaining the location of the mobile computer further comprises receiving GPS location information on the mobile computer, as taught by Freathy, for the advantage of receiving the location of the mobile computer and retrieving the mobile computer.

Considering claim 16, Iwasa further teaches allowing the BIOS password requirement to be removed once a valid BIOS password has been given and the system has returned to normal operating state ([0040]). It is convenient to activate the system and use the mobile computer after retrieving the unit.

Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the combined system of Lee, Freathy, and Iwasa to include allowing the BIOS password requirement to be removed once a valid BIOS

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password has been given and the system has returned to normal operating state, as taught by Iwasa, for the advantage of activating the system and use the mobile computer after retrieving the unit.

5. Claims 7, 14, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,741,851 Lee et al. (Lee), US Patent No. 6,774,797 Freathy et al. (Freathy) and US Patent Application No. 2003/0199267 Iwasa et al. (Iwasa) as applied to claim 4 above, and further in view of US Patent No. 6,757,531 Haaramo et al. (Haaramo).

Considering claim 7, the combined system of Lee, Freathy and Iwasa teaches the method of claim 4 but failed to further teaches receiving the queued message upon entering the wireless network if the mobile computer was outside of the range of the wireless network when the message was received.

In an analogous art, Haaramo teaches receiving the queued message upon entering the wireless network if the mobile computer was outside of the range of the wireless network when the message was received (col. 9 lines 18-36). It is convenient to send the message when the mobile computer enters the wireless network to ensure that the user receives the message.

Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the combined system of Lee, Freathy and Iwasa to receive the queued message upon entering the wireless network if the mobile computer was outside of the range of the wireless network when the message was

received, as taught by Haaramo, for the advantage of ensuring that the user receives the message.

Considering claim 14, the combined system of Lee, Freathy and Iwasa teaches the method of claim 4 but failed to teach queuing the message further comprises storing the message on a message server located on the wireless network.

In an analogous art, Haaramo further teaches queuing the message further comprises storing the message on a message server located on the wireless network (communication server, col. 9 lines 32-37). It is convenient to send the message to the message server so that the server can send the message out when the mobile computer is detected.

Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the combined system of Lee, Freathy, and Iwasa to store the message on a message server located on the wireless network, as taught by Haaramo, for the advantage of sending the message to the user when the mobile computer is detected.

Considering claim 15, the combined system of Lee, Freathy and Iwasa teaches the method of claim 4 but failed to teach storing the message in an always-on wireless subsystem located within the wireless computer.

In an analogous art, Haaramo further teaches queuing the message further comprises storing the message in an always-on wireless subsystem (master terminal)

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located within the wireless computer (col. 9 lines 38-47). It is convenient to store the message in an always-on wireless subsystem so that the server would save resources on saving the messages.

Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the combined system of Lee, Freathy and Iwasa to store the message in an always-on wireless subsystem located within the wireless computer, as taught by Haaramo, for the advantage of saving resources for the server.

6. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 6,741,851 Lee et al. (Lee) as applied to claim 1 above, and further in view of US Patent No. 6,774,797 Freathy et al. (Freathy).

Considering claim 11, Lee teaches a wireless network but failed to mention the wireless network further comprises a cellular network.

In an analogous art, Freathy teaches a cellular network (col. 2 lines 65-67). It is convenient to include a cellular network to obtain information about the location of the mobile unit relative to the individual cell sites (col. 2 lines 52-58).

Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify Lee's system to include a cellular network, as taught by Freathy, for the advantage of obtaining information about the location of the mobile unit relative to the individual cell sites.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

US Patent No. 6,230,002 (Floden et al.) teaches a method, and associated apparatus, improves the authentication security of authentication procedures performed by a wireless host when requesting access to communicate with a host site of a private network. US Patent No. 6,148,212 (Park et al.) teaches a telecommunications system and method is disclosed for instructing a device interfaced with a vehicle's electrical system to activate or deactivate specific electrical devices, using the cellular network. US Patent No. 5,898,783 (Rohrbach) teaches having a subscriber identity module in a smartcard that cooperates with a mobile station to effect communication with a telecommunications network, a system for, and method of, disabling the smartcard. US Patent No. 5,862,472 (Park) teaches a circuit and method for a portable telephone prevents a finder from exploiting the interests of the owner if the telephone becomes lost.


8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gary Au whose telephone number is (571) 272-2822. The examiner can normally be reached on 8am-4pm Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

GA


NICK CORSARO
PRIMARY EXAMINER